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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/931,881 | 08/20/2001 | Masaaki Nakashima | P21017 | 4044 |

7055 7590 02/28/2005

GREENBLUM & BERNSTEIN, P.L.C.
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RESTON, VA 20191

EXAMINER

AN, SHAWN S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2613

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/931,881 | NAKASHIMA, MASAOKI | |
| | Examiner | Art Unit | |
| | Shawn S An | 2613 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. As per Applicant's instructions as filed on 9/30/04, claims 1-3, 5, 8-9, 10-11, 13, and 16-17 have been amended.

Response to Remarks

2. Applicant's remarks filed on 9/30/04 have been fully considered but they are not persuasive.

The Applicant presents arguments of which the cited prior art references fail to disclose such features as A) the predetermined circuit being arranged along the periphery of the light receiving surface of the image sensor on the base so that a center of the base on the light receiving surface of the image sensor is substantially aligned with a center of the effective imaging region of the image and B) configuration of an image sensor and a predetermined circuit mounted on a base.

However, after careful scrutiny of the previously cited prior art references, the Examiner must respectfully disagree, and maintain the grounds of rejection for the reasons that follow.

In response to argument A), Nakamura discloses a predetermined circuit (intricate circuitry of the conventional endoscope utilizing CCD (image sensor), inherency is emphasized, because one of an endoscope's inherent function is to capture and take out an image signal from the image sensor) being arranged along the periphery of the light receiving surface of the image sensor (Fig. 15, CCD) on the base (Fig. 18, 85) so that a center (see optical axis) of the base on the light receiving surface (coincides with the optical axis of the objective lens system (80)) of the image sensor is substantially aligned with a center (Fig. 15, line C) of the effective imaging region of the image sensor (Figs. 15 and 18; col. 15, lines 2-14).

Furthermore, in contrast to Applicant's assertion that the alignment disclosed in Nakamura is not between a center of base and the center of the image sensor, but between a center of lens and a center of the CCD, the alignment as depicted on figure

18 illustrates a center (see optical axis, d6) of the base (85) being substantially aligned with a center (Fig. 15, line C) of the effective imaging region of the image sensor.

In response to argument B), Nakamura discloses configuration of an image sensor (Fig. 15, CCD) and a predetermined circuit (intricate circuitry of the conventional endoscope utilizing CCD (inherency is emphasized, because one of an endoscope's inherent function is to capture and take out an image signal from the image sensor) mounted on a base (Fig. 18, 85).

Note: the claimed limitation "base" is met by the element 85, whether the base is made up of glass or anything else. Therefore, at least the claimed limitation "base" has been met by the element 85.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura (6,476,851 B1) as previously discussed in the last office action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (6,476,851 B1) as previously discussed in the last office action.

7. Claims 3-6, 8, 11-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (6,476,851 B1) in view of Sasaki (5,408,265) as previously discussed in the last office action.

8. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura and Sasaki as applied to claims 3 and 11 above, respectively, and further in view of Kimura (4,489,350) as previously discussed in the last office action.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn S An* whose telephone number is 703-305-0099. The Examiner can normally be reached on Flex hours (10).

Art Unit: 2613

11. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SSA

Primary Patent Examiner

2/18/05